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			3626	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/802,334

Applicant(s)

LUX, CINDY M.

Examiner

Natalie A. Pass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 29 August 2005. Claims 1-2, 5-6, 10-12, 16-22, and 27-28 have been amended. Claims 1-29 remain pending.

Specification

2. The amendment filed 29 August 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

- a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

- b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc. The added material which is not supported by the original disclosure is as follows:

- "between the payor and the patient at the kiosk" as disclosed in claim 1, line 14;
- "eligibility confirmation requests sent by the patient" as disclosed in claim 1, lines 15-16;
- "between the patient and the payor" as disclosed in claim 6, lines 2-3;
- "eligibility confirmation interface is initiated by the patient at the kiosk" as disclosed in claim 11, line 2;

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- "electronic communication link between the patient and the payor," as disclosed in claim 11, line 4;
- "eligibility confirmation requests sent by the patient at the kiosk" as disclosed in claim 12, lines 16-17;
- "communication link between the patient and the payor," as disclosed in claim 16, lines 5-6;
- "health provider database" as disclosed in claim 16, lines 2-3; and
- "electronic data interchange (EDI) between the patient and the payor" as disclosed in claim 17, line 23;
- "immediately confirm" as disclosed in claim 19, line 3;
- "payor database" as disclosed in claim 20, lines 2-3; and
- "payor to confirm a co-pay" as disclosed in claim 27, line 2.

In particular, Applicant does not point to, nor was the Examiner able to find, any support for this newly added language within the specification as originally filed on 17 March 2004. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

3. If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. While an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 17 March 2004.

Claim Rejections - 35 USC § 112

4. Claims 1-29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A) Claims 1, 6, 11, 12, 16, 17, 19, 20 and 27 recite limitations that are new matter, as discussed above, and are therefore rejected.

(B) Dependent claims 2-5, 7-10, 13-15, 18, 21-26, 28-29 incorporate the features of independent claims 1, 12, and 17, through dependency and are also rejected.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burko, U.S. Patent Application Publication 2002/0156672 A1, in view of Boyer et al., U.S. Patent Number 6,208,973, and Sugiyama, European Patent Application EP 0 696 006 A2 for substantially the same reasons given in the previous Office Action (paper number 04212005), and further in view

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of Fitzgerald et al., U.S. Patent Application Publication 2003/0191669 A1. Further reasons appear below.

(A) Claim 1 has been amended to include the recitation of

- ♦ "self-register" and "provided on said kiosk" in line 3;
- ♦ "healthcare provider" and "for review by the patient" in line 5;
- ♦ "for review and updating by the patient at the kiosk" in lines 10-11;
- ♦ "patient at the kiosk" in line 14; and
- ♦ "at said kiosk" in line 19.

As per these new limitations Burko, Boyer and Sugiyama teach a patient registration kiosk system that allows patients to self-register for an appointment with a healthcare provider (Burko; paragraph [0015], paragraphs [0060]-[0061] as analyzed and disclosed in the previous Office Action (paper number 04212005), further comprising:

a self-register patient identification mechanism provided on said kiosk (Burko; paragraph [0015], paragraphs [0060]-[0061];

retrieved from a healthcare provider database for review by the patient (Burko; see at least Figure 3, Item 98, paragraph [0015], paragraph [0049], paragraph [0061]);

an insurance card "reader" (reads on "scanner") at said "personal computer" (reads on "kiosk" (Sugiyama; see at least column 4, lines 8-20, 32-33, column 6, lines 4-6, 33-34).

Although Burko, Boyer and Sugiyama teach an eligibility confirmation interface for forming an electronic communication link between the payor and the healthcare provider (Boyer; Figure 1, column 4, lines 36-49, column 7, lines 33-38, column 12, lines 52-55), and

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“coverage profile [reads on “eligibility confirmation”] for the patient may also be provided to the healthcare provider for comparison with a preliminary diagnosis for healthcare services to be provided to the patient prior to providing healthcare services to the patient” (Boyer; column 4, lines 49-54), Burko, Boyer and Sugiyama fail to explicitly disclose

for review and updating by the patient at the kiosk; and

an eligibility confirmation interface for forming an electronic communication link between the payor and the patient at the kiosk.

However, the above features are well-known in the art, as evidenced by Fitzgerald.

In particular, Fitzgerald teaches

for review and updating by the patient at the “user interface” (reads on “kiosk”)

(Fitzgerald; Figure 3, Items 317 and 319, paragraph [0015]); and

an eligibility confirmation interface for forming an electronic communication link between the payor and the patient at the “user interface” (reads on “kiosk”) (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined art of Burko, Boyer and Sugiyama to include an eligibility confirmation interface for forming an electronic communication link between the payor and the patient as taught by Fitzgerald, with the motivations of allowing “a patient or fiscally responsible party to interact directly with payer organizations and healthcare providers to communicate concerns about information viewed or to request that incorrect information be corrected” (Fitzgerald; paragraph [0015]).

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The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 3-6), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer and Sugiyama are as given in the in the claim 1 rejection in the prior Office Action (paper number 04212005), and incorporated herein.

(B) Claim 2 has been amended to include the recitation of

- ♦ “patient’s registration” in line 2;
- ♦ "and further including at least one of the group consisting of: patient name, unique patient identification number, insurance plan, insurance identification number, insurance type, and primary care physician” in lines 4-7.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim 1 above further comprising

an output device for providing a “reception ticket” (reads on “receipt”) relevant to the patient’s “reception” (reads on “registration”) (Sugiyama; column 1, line 50 to column 2, line 11);

and further including patient name, unique patient identification number, and insurance plan, (Sugiyama; Figure 5, column 1, line 57 to column 2, line 5, column 2, lines 56-58, column 4, lines 20-21).

The remainder of claim 2 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 5-6), and incorporated herein.

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The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(C) Claim 5 has been amended to include the recitation of

- ♦ “and/or a scanner with optical character recognition (OCR) capabilities” in lines 2-3.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim 1 above further comprising

wherein the patient identification mechanism includes one of a barcode scanner, a card reader and/or a scanner with optical character recognition (OCR) capabilities (Burko; paragraphs [0032]-[0035]), (Sugiyama; Abstract, column 2, lines 2-11).

The remainder of claim 5 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages6-7), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(D) Claim 6 has been amended to include the recitation of

- ♦ between the “patient” and the payor in line 3.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim 1 above, further comprising

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wherein the eligibility confirmation interface forms part of an electronic data interchange (EDI) between the patient and the payor (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]).

The remainder of claim 6 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 6-7), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(E) The amendments to claims 10 and 22 appear to have been made merely to correct minor typographical or grammatical errors. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, page 8), and incorporated herein.

(F) Claim 11 has been amended to include the recitation of

- ♦ “is initiated by the patient at the kiosk,” in line 2; and
- ♦ electronic communication link between the “patient” and the payor, in line 4.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claims 1 and 9-10 above, further comprising

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wherein the eligibility confirmation interface is initiated by the patient at the “user interface” (reads on “kiosk”) (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]); and
electronic communication link between the patient and the payor to confirm the patient’s eligibility for coverage (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]).

The remainder of claim 11 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, page 8), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(G) Claim 12 has been amended to include the recitation of

- ♦ “and/or card reader coupled to said kiosk,” in line 3;
- ♦ “wherein said patient engages said scanner and/or card reader,” in lines 5-6;
- ♦ “coupled to said kiosk allowing said patient to engage the reader,” in line 10;
- ♦ “and eligibility of the patient” in line 11;
- ♦ “an electronic communication link between the payor and the patient,” in lines 14-15;
- ♦ eligibility confirmation requests sent by the “patient at the kiosk,” at lines 16-17;
- ♦ “and/or for capturing optical character recognition (OCR) data for identification of the insurance information,” in lines 21-22.

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As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and disclosed in the previous Office Action (paper number 04212005), further comprising

scanner and/or card reader coupled to said “personal computer” (reads on “kiosk” (Sugiyama; see at least column 4, lines 8-20, 32-33, column 6, lines 4-6, 33-34);

wherein said patient “places a health insurance card ... on the data reader” (reads on “engages said scanner and/or card reader”) (Sugiyama; column 2, lines 2-4);

coupled to said kiosk allowing said patient to engage the reader (Sugiyama; column 2, lines 2-4, column 4, lines 8-20, 32-33, column 6, lines 4-6, 33-34);;

and eligibility of the patient (Sugiyama; column 1, lines 41-46, column 2, lines 56-58, column 3, lines 55-57); Examiner interprets “determining whether the patient is the beneficiary of the health insurance” as reading on this limitation;

an electronic communication link between the payor and the patient (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]);

eligibility confirmation requests sent by the patient at the “user interface” (reads on “kiosk”) (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]);

and/or for capturing optical character recognition (OCR) data for identification of the insurance information (Sugiyama; column 1, lines 53-54); Examiner interprets Sugiyama’s teaching of “character recognition means converting a specific region of the image data into a character data” as teaching this limitation).

The remainder of claim 12 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 8-10), and incorporated herein.

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The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(H) Claim 16 has been amended to include the recitation of

- ♦ "healthcare provider database" in lines 2-3;
- ♦ "patient" in line 5.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim12 above, further comprising

communicatively couples the healthcare provider database (Boyer; Figure 2A, Figure 2B, column 8, lines 6-41);

a communication link between the patient and the payor (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]).

The remainder of claim 16 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 10-11), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(I) Claim 17 has been amended to include the recitation of

- ♦ "healthcare provider database by said patient at said kiosk" in lines 4-5;
- ♦ "and eligibility of the patient," in line 10;

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- ♦ “wherein said patient reviews and updates said insurance plan information at the kiosk at each visit,” in lines 10-12;
- ♦ “wherein the insurance plan identification mechanism includes one of a barcode scanner, a card reader and/or a scanner with optical character recognition (OCR) capabilities” in lines 13-15;
- ♦ “electronic communication link between the payor and the “patient,” on line 17;
- ♦ “patient at the kiosk,” in lines 18-19;
- ♦ and wherein the eligibility confirmation interface forms part of an electronic data interchange (EDI), between the patient and the payor,” at lines 21-23.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and disclosed in the previous Office Action (paper number 04212005), further comprising

healthcare provider database by said patient at said kiosk (Boyer; Figure 2A, Figure 2B, column 8, lines 6-41), (Burko; paragraph [0015], paragraph [0049], paragraph [0061]);

and eligibility of the patient (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]); wherein said patient reviews and updates said insurance plan information at the kiosk at each visit (Burko; see at least Figure 5, Item 168, paragraph [0015]);

wherein the insurance plan identification mechanism includes one of a barcode scanner, a card reader and/or a scanner with optical character recognition (OCR) capabilities (Burko; paragraphs [0032]-[0035]), (Sugiyama; Abstract, column 2, lines 2-11);

electronic communication link between the payor and the patient (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]);

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patient at the "user interface" (reads on "kiosk") (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]); and

and wherein the eligibility confirmation interface forms part of an electronic data interchange (EDI), between the patient and the payor (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]).

The remainder of claim 17 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 12-14), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(J) Claim 18 has been amended to include the recitation of

- ♦ "healthcare provider database" in lines 2-3;

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim17 above, further comprising

communicatively couples the healthcare provider database (Boyer, Figure 2A, Figure 2B, column 8, lines 6-41).

The remainder of claim 18 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 13-15), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(K) Claim 19 has been amended to include the recitation of

- ♦ "to enable healthcare provider staff to refer to on-line insurance benefits of said patient to immediately confirm benefit coverage" in lines 2-3.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim17 above, further comprising

to enable healthcare provider staff to refer to on-line insurance benefits of said patient to immediately or in "real-time," confirm benefit coverage (Boyer; column 7, lines 33-38).

The remainder of claim 19 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 13-15), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(L) Claim 20 has been amended to include the recitation of

- ♦ "on a payor database" in lines 2-3.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim17 above, further comprising

on a payor database (Boyer; Figure 2A, Figure 2B, column 8, lines 6-41)., (Sugiyama; Figure 1, Figure 2, column 4, lines 3656, column 6, lines 34-42).

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The remainder of claim 20 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 13-15), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(M) Claim 21 has been amended to include the recitation of

- ♦ “communicatively couples the healthcare provider database “ on line 2.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim17 above, further comprising

communicatively couples the healthcare provider database (Boyer, Figure 2A, Figure 2B, column 8, lines 6-41).

The remainder of claim 21 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, pages 13-15), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(N) Claim 27 has been amended to include the recitation of

- ♦ “payor” to confirm on line 2.

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As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim17 above, further comprising

wherein the eligibility confirmation interface further allows the payor to confirm a co-pay associated with the patient (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]).

The remainder of claim 27 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, page 15), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(O) Claim 28 has been amended to include the recitation of

- ♦ “to view on-line provider information, and to confirm” on lines 2-3.

As per these new limitations Burko, Boyer, Sugiyama and Fitzgerald teach a system as analyzed and discussed in claim17 above, further comprising

to view on-line provider information, and to confirm particular plan benefits (Boyer; column 4, lines 36-53, column 6, lines 22-61).

The remainder of claim 28 is rejected for the same reasons given in the prior Office Action (paper number 04212005, section 4, page 15), and incorporated herein.

The motivations for combining the respective teachings of Burko, Boyer, Sugiyama and Fitzgerald are as given in the in the claim 1 rejections in the prior Office Action (paper number 04212005) and above, and incorporated herein.

(P) Claims 3-4, 7-9, 13-15, 23-26, 29 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 04212005, section 4, pages 6-15), and incorporated herein.

Response to Arguments

7. Applicant's arguments filed 29 August 2005 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response 29 August 2005.

(A) At pages 10-19 of the 29 August 2005 response, Applicant argues that the features in the application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes are missing in the applied references have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Burko, Sugiyama Labelle and Fitzgerald, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the preceding sections of the present Office Action and in the prior Office Action (paper number 04212005), and incorporated herein. In particular, Examiner notes that Burko, Sugiyama Labelle and Fitzgerald teach "an eligibility confirmation interface for forming an electronic communication link between the payor and the patient at the "user interface" (reads on "kiosk")" (Fitzgerald; Figure 2, paragraphs [0005], [0015], [0025]) in which the patient receives eligibility "verification" (reads on "confirmation").

With respect to Applicant's argument at paragraph 2 of page 11 of the 29 August 2005 response that the applied references fail to disclose "system that allows patients to self register prior to an appointment" as recited in the preamble of claim 12, Examiner respectfully disagrees and notes that Examiner interprets Burko's teachings of "each customer may interface with the system" and "registration information is obtained" and "if the customer is authorized ...[...]. . . schedule an appointment" and "[t]he registration information may also include information relating to the service, such as preferences, billing information, insurance information, or any other useful information," as recited in paragraph [0047]-[0050] and as shown in Figure 3, to read on this preamble.

With respect to Applicant's argument at paragraph 3 of page 11 of the 29 August 2005 response that the applied references fail to disclose "for review and updating by the patient at the kiosk" and "an eligibility confirmation interface for forming an electronic communication link between the payor and the patient" Examiner respectfully disagrees. Examiner interprets Fitzgerald's teachings of "in response to the patient command" and "updating a medical record of said patient in a database" and "a patient...[...]. . . has the opportunity to correct data" (Fitzgerald; Figure 3, Items 317 and 319, paragraph [0015]) to read on the first limitation and Fitzgerald's teachings of "system uses aggregated healthcare encounter service, billing, and claim data to enable an authorized patient to access healthcare encounter related information concerning pre-certifications, referrals, eligibility verification, healthcare services availability,

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co-payments, deductibles, claims and payment status" (Fitzgerald; Abstract); to read on the second limitation.

With respect to Applicant's argument at paragraph 1 of page 12 of the 29 August 2005 response that the Burko reference fail to discloses certain limitations, Examiner notes that it was the Fitzgerald reference and not the Burko reference that was applied as teaching those limitations.

With respect to Applicant's arguments on pages 12-14 of the 29 August 2005 response, and to Applicant's objection to Examiner's taking of Official Notice, Examiner respectfully notes that no Official Notice was taken in the previous Office Action, and further that these arguments are moot in view of the new grounds of rejection.

With respect to Applicant's arguments at paragraph 2 of page 14 of the 29 August 2005 response that "Sugiyama does not disclose anything in relation to imaging both sides of a card" Examiner respectfully notes that this is limitation is not recited in the claim language.

With respect to Applicant's arguments at paragraph 1 of page 15 of the 29 August 2005 response that Sugiyama does not disclose confirmation eligibility with the payor, Examiner respectfully notes it was that it was the Fitzgerald reference and not the Sugiyama reference that was applied as teaching those limitations.

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With respect to Applicant's arguments at paragraph 2 of page 15 of the 29 August 2005 response, and to Applicant's objection to Examiner's taking of Official Notice, Examiner respectfully notes that no Official Notice was taken in the previous Office Action, and further notes that the limitation of "scanning both sides of a single card" is not recited in the claim language. Instead, claim 1 recites "an insurance card scanner at said kiosk adapted to generate an image of each side of an insurance card associated with the patient for storage in the database" (emphasis added); Examiner interprets Sugiyama's teachings of "insurance card reader" (reads on "scanner") that stores images in "the patient's master file" (reads on "database") (Sugiyama; column 4, lines 8-33 column 6, lines 4-6) to teach these recited limitations.

With respect to Applicant's arguments at paragraph 3 of page 15 of the 29 August 2005 response, Examiner notes that claim 2 recites "an output device for providing a receipt relevant to the patient's registration" (emphasis added); Examiner notes that it was the Sugiyama reference and not the Boyer reference that was applied to this limitation and that, furthermore, Examiner interprets Sugiyama's teachings of "processing means" that "issues a reception ticket" (reads on "receipt") relevant to the patient's "reception" (reads on "registration") (Sugiyama; column 1, line 50 to column 2, line 11) as teaching these recited limitations.

With respect to Applicant's arguments at paragraph 2 on page 16 and paragraph 1 on page 17 of the 29 August 2005 response, Examiner respectfully notes that these arguments are moot in view of the new grounds of rejection. Additionally, in the last sentence of paragraph 1 Applicant argues "the receipt of the present invention includes insurance plan information and

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eligibility confirmation as provided by the communications link with the payor," however these limitations are not recited in the claim language.

In response to Applicant's argument at paragraph 2 on page 17 of the 29 August 2005 response that there is no suggestion to combine the references, and that "it is inappropriate to use the Applicant's claims as a road map in selecting a combination of references to form a 103 rejection," the Examiner notes that the motivations for combining the applied references can be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant application the motivations have been found in the references themselves. For example, the Examiner noted that motivation to combine Fitzgerald with the Burko, Boyer and Sugiyama references, was that of allowing "a patient or fiscally responsible party to interact directly with payer organizations and healthcare providers to communicate concerns about information viewed or to request that incorrect information be corrected", which is taken solely from the teachings of Fitzgerald (paragraph [0015]).

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references is accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has

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been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood* 28 USPQ 2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Consequently, it is respectfully submitted that contrary to Applicant's allegations, the features that Applicant disputes are clearly within the teachings of the applied references and that Applicant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

Moreover, with respect to Applicant's argument that a *prima facie* case of obviousness has not been established the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 04212005 and present Office Action) have been expressly articulated.

In response to Applicant's argument at pages 17-18 of the 29 August 2005 response that the Examiner's conclusion of obviousness is based upon "a road map" of Applicant's claims or improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into

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account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

At pages 17-18 of the 29 August 2005 response, Applicant argues that the cited references are non-analogous art. Examiner respectfully disagrees.

In response to Applicant's argument that the Burko, Sugiyama Labelle and Fitzgerald references are non-analogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

Firstly, the Examiner respectfully submits that the prior art references are in the field of Applicant's endeavor. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant's invention pertains to healthcare administration, and more particularly, to a patient registration kiosk that enables both self-registration for the patient, and efficient and accurate data for billing and claim management by the care provider (see Specification, paragraph [0002]). The Examiner respectfully submits in this case that the primary reference, Burko, was relied upon for teaching a method of increasing the quality of care that may be provided to patients and that enables patients to self-register at a computer device or kiosk (Burko; paragraph [0009], [0015]. Boyer discloses verifying patient eligibility for third party payor services prior to provision of healthcare services by the healthcare provider (Boyer; column 4, lines 41-47). Sugiyama teaches verification of patient health insurance information, electronically scanning

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image and character data from health insurance cards, and provision of a registration receipt (Sugiyama; column 2, lines 1-10, 55-58, column 3, lines 55-58, column 4, lines 7-20). Fitzgerald teaches enabling a patient to electronically access healthcare information (Fitzgerald; Abstract).

Thus, the skilled artisan viewing Burko, Sugiyama Labelle and Fitzgerald collectively would have realized Burtko's invention for increasing the quality of care that may be provided to patients and that enables patients to self-register at a computer device or kiosk was taken in combination with Boyer's invention of verifying patient eligibility for third party payor services prior to provision of healthcare services and Sugiyama's teachings pertaining to verification of patient health insurance information, electronically scanning image and character data from health insurance cards, and provision of a registration receipt and Fitzgerald's teaching of enabling a patient to electronically access healthcare information. Thus, it is the position of the Examiner that Burko, Sugiyama Labelle and Fitzgerald are in the field of the Applicant's endeavor, and are therefore analogous art.

Secondly, the Examiner respectfully submits that the prior art references are reasonably pertinent to the particular problem with which the Applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Burko is directed to solving the problem of improving healthcare administration by allowing patients or customers to self-register efficiently (Burko; paragraphs [0009]-[0015]). The present application also seeks to solve a similar problem, namely, enabling self-registration for the patient and efficient and accurate data for billing and claim management by the care provider (see paragraph [0002] of specification). Thus, it is the position of the Examiner that the prior art references are reasonably pertinent to the

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particular problem with which the Applicant was concerned and the applied references are analogous art as both relate to producing efficient patient registration management.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark

"EXPEDITED PROCEDURE".

For informal or draft communications, please

label **"PROPOSED"** or **"DRAFT"** on the front page of

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the communication and do NOT sign the
communication.

After Final communications should be labeled "Box AF."


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

November 14, 2005


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER